

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: Application of: **Guillermo Silva** Date: November 3, 2006
Application No. **10/765,193** Art Unit: **1761**
Filed: **1/28/2004** Examiner: **Helen F. Pratt**
Attorney Docket. No. **060014**
Title: **COCONUT BEVERAGE AND METHOD OF PRODUCING
THE SAME**

APPEAL BRIEF

Certificate of Transmission

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FROM: ALBERT BORDAS, P.A.
5975 Sunset Drive, Unit 607
Miami, Florida 33143
Ph:(305) 669-9848/ Fax:(305) 669-9851

TO: **Commissioner for Patents**
Attn. **Mail Stop Appeal Brief- Patents**
P.O. Box 1450
Alexandria, Virginia 22313-1450

Papers included: Appeal Brief under 37 CFR 41.37 and fee set forth in 37 CFR 41.20(b)(2).

Albert Bordas, Esq. 45,595
Name of person signing Certificate Registration No., if applicable

/Albert Bordas/
Signature

(A) IDENTIFICATION PAGE

Applicant's name: Guillermo Silva

Application No.: 10/765,193

Filing Date: 1/28/2004

Title of the invention: COCONUT BEVERAGE AND METHOD OF PRODUCING THE SAME

Name of the Examiner: Helen F. Pratt

Art Unit: 1761

Title of the paper: Appeal Brief

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(C) REAL PARTY IN INTEREST

The real party in interest is an individual, **Guillermo Silva**, who is the inventor of the present invention.

(D) RELATED APPEALS AND INTERFERENCES

None.

(E) STATUS OF CLAIMS

Claim 1 is rejected.

Claim 2 is cancelled.

Claim 3 is cancelled.

Claim 4 is cancelled.

Claim 5 is cancelled.

Claim 6 is cancelled.

Claim 7 is rejected.

Claim 8 is cancelled.

(F) STATUS OF AMENDMENTS

On July 25, 2006, Applicant filed a Petition for Reconsideration After Final Office Action with Amendment. On August 4, 2006 the Examiner issued an Advisory Action indicating that the Petition for Reconsideration After Final Office Action with Amendment did not place the application in condition for allowance because of the state of the prior art, therefore rejecting all of the claims (claims 1 and 7).

The Applicant considers the claims on appeal to be:

1. (Previously amended) A ~~spray dried~~ rich creamy coconut mixture comprising consisting of:

A) water;

B) a contained and preserved liquid base developed from mixing water, sugar and a coconut cream powder derivative of natural coconut that is processed from natural coconut milk through a spray drying process, said spray drying process is a unit operation where a pumpable said coconut milk liquid feed is finely dispersed or atomized to form droplets that are sprayed into a heated air chamber and to facilitate dehydration dehydration of said droplets, thus forming powder particles, said powder particles are conveyed to a cyclone where said coconut cream powder is collected;

C) sugar;

D) ice; and

E) contained in a first container and preserved young coconut meat originating from said natural coconut at its immature stage to resemble texture, consistency, taste, and appearance of mixing natural coconut liquid endosperm with jelly-like meat of an immature said natural coconut recently picked from a coconut palm tree, said coconut cream powder derivative comprises said natural coconut and a starch hydrolysis product, said starch hydrolysis product is maltodextrin, said young coconut meat contains mainly water and said jelly-like meat which are collected, bleached and contained in a second container with preservatives.

2. (Cancelled)

3. (Cancelled)

4. (Cancelled)

5. (Cancelled)

6. (Cancelled)

7. (Currently amended) The rich creamy coconut beverage mixture set forth in claim [[6]] 1, further characterized in that said rich creamy coconut beverage has comprising vanilla extract.

8. (Cancelled)

(G) SUMMARY OF CLAIMED SUBJECT MATTER

In Independent Claim 1, the Applicant refers to a rich creamy coconut mixture, as referred to on Page 9, Lines 23 through 26 of the specification, consisting of:

A) water, as referred to on Page 10, Line 8 of the specification;

B) a contained and preserved liquid base developed from mixing water, sugar and a coconut cream powder derivative of natural coconut that is processed from natural coconut milk through a spray drying process, said spray drying process is a unit operation where a pumpable said coconut milk liquid feed is finely dispersed or atomized to form droplets that are sprayed into a heated air chamber to facilitate dehydration of said droplets, thus forming powder particles, said powder particles are conveyed to a cyclone where said coconut cream powder is collected, as referred to on Page 10, Lines 5 through 22 of the specification;

C) sugar, as referred to on Page 10, Line 8 of the specification;

D) ice, as referred to on Page 12, Line 15 of the specification; and

E) contained in a first container and preserved young coconut meat originating from said natural coconut at its immature stage to resemble texture, consistency, taste, and appearance of mixing natural coconut liquid endosperm with jelly-like meat of an immature said natural coconut recently picked from a coconut palm tree, said coconut cream powder derivative comprises said natural coconut and a starch hydrolysis product, said starch hydrolysis product is maltodextrin, said young coconut meat contains mainly water and said jelly-like meat which are collected, bleached and contained in a second container with preservatives., as referred to on Page 10, Lines 24 through 7, Page 11, Lines 9 through 26 and Page 13, Lines 2 through 9 of the specification.

In dependent Claim 7, Applicant is claiming that the rich creamy coconut mixture set forth in claim 1, further comprises vanilla extract referred to on Page 12, Lines 21 and 22 of the specification.

(H) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

First Office Action

In the first Office Action dated December 21, 2005, the Examiner rejected claim 1 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Also, the Examiner stated that claims 1 and 6 were indefinite in the use of the word “contained” in step E in claim 1, and line 3 in claim 6, because it was not known what is meant by this term, i.e. whether it was a container or not.

In addition, the Examiner rejected claims 1-8 under 35 U.S.C. 103(a) as being unpatentable over Leaflet No. 8, 1983, in view of Tayag (PH26114).

Notice of Non-Compliant Amendment

In the Notice of Non-Compliant Amendment dated February 17, 2006, the Examiner stated that “double brackets should be used to delete 5 or fewer consecutive characters”

Second Office Action (Final)

In the second Office Action (Final) dated April 7, 2006, the Examiner rejected claims 1 and 6 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner stated that claims 1 and 6 were

deemed indefinite in the use of the word “contained” in step E in claim 1, and line 3 in claim 6, because it was not known what is meant by this term, i.e. whether it was a container or not. This rejection was maintained by the Examiner. Also, the Examiner considered Claims 1 and 6 were indefinite in the use of the phrase “liquid feed”. The Examiner considered that it was not known what the composition of the “liquid feed” was.

In addition, the Examiner rejected claims 1 and 8 as being indefinite in the use of the phrase “A spray dried rich creamy coconut mixture” or “A method to develop a spray dried rich creamy coconut mixture”. The Examiner stated that the mixture is not spray dried. Only the coconut milk is spray dried.

The Examiner further noted that “Dehydration” was misspelled and that in claim 1, 3 lines from the bottom there should be a “to” instead of an “and” in front of “facilitate”.

Finally, the Examiner rejected claims 1, 2, 4-8 under 35 U.S.C. 103(a) as being unpatentable over Leaflet No. 8, 1983, in view of Tayag (PH26114) and Beyerinck et al. (6,763,607).

Advisory Action

In the Advisory Action dated August 4, 2006, the Examiner maintained the rejection of amended claims 1 and 7. The Examiner

informed that the Request for Reconsideration was considered but does not placed the application in condition for allowance.

(I) ARGUMENT

First Office Action

Rejection under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

“Claim 1” and “Claim 6”

On January 20, 2006, the Attorney for Applicant had a telephonic interview with Examiner Helen F. Pratt. Applicant discussed the use of the word “contained” in step E of claims 1 and 6, but Applicant inadvertently omitted language in the First Amendment describing the term “contained”.

Rejection under 35 U.S.C. 103(a) over Leaflet No. 8, 1983, in view of Tayag (PH26114).

“Claim 1”, “Claim 2”, “Claim 4”, “Claim 6”, “Claim 6”, “Claim 7”, and “Claim 8”

On January 20, 2006, Attorney had a telephonic interview with Examiner Helen F. Pratt. Accordingly, Applicant adopted the Examiner’s suggestions and amended the claims to obviate the Examiner’s objections under 35 U.S.C. 103(a).

Applicant canceled claim 3 and added the limitations of the cancelled claim 3 into claim 1. Applicant adopted the Examiner's suggestions by amending claim 8.

Notice of Non-Compliant Amendment

Notice of Non-Complaint Amendment wherein double brackets should be used to delete 5 or fewer consecutive characters.

“Claim 4”

Applicant filed a corrected section Amendments to the Claims. Applicant amended claim 4 using double brackets instead of strikethrough to delete 5 of fewer consecutive characters, as suggested by the Examiner.

Second Office Action (Final)

Rejection under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

“Claim 1” and “Claim 6”

With regard to the word “contained”, the Applicant stated that it referred to young coconut meat in a can, and therefore being contained. Applicant respectfully directed the Examiner to Page 11, Lines 16 – 26 of the Specification, where it states:

The jelly-like meat is canned. When the fruit has been harvested from the palm tree the coconut is opened and the jelly-like meat is collected, bleached and canned with citric acid (approximately 0.1 %) and sodium metabisulfite (approximately 0.02%), with a concentration of 10-40 ppm maximum to control the pH. It is noted that the citric acid and sodium metabisulfite may be replaced by other matter having similar properties and characteristics. In this canned form with preservatives, the jelly-like meat can be handled while avoiding the natural limitations of the immature coconut such as, but limited to, preservation for extended shelf life. In addition, the pH is used for government importation regulations. Other pH adjustors can be used.

Applicant amended claims 1 and 6 to be more specific as to the word "contained".

"Claim 1" and "Claim 6"

With regard to the phrase "liquid feed", Applicant respectfully directed the Examiner to Page 10, Lines 14 – 22 of the Specification, where it states:

Product A is a derivative of real coconut that goes from coconut milk, or a similar source material, to coconut cream powder, or a similar source material, through a delicate process called spray drying. Spray drying is a unit operation where a pumpable liquid feed is finely dispersed or atomized to form

droplets, which are sprayed into a heated air chamber. The process facilitates the dehydratacion of the feed droplets, thus forming the powder particles. The powder is then conveyed to a highly efficient cyclone where product is collected in a container while the spent drying air is exhausted to the atmosphere.

The composition of the liquid feed is the coconut milk defined above. Applicant has amended claims 1 and 6 to be more specific as to the liquid feed composition being coconut milk.

“Claim 1” and “Claim 8”

With regard to the coconut milk being spray dried and not “A spray dried rich creamy coconut mixture” or “A method to develop a spray dried rich creamy coconut mixture”, Applicant respectfully directed the Examiner to Page 10, Lines 14 – 22 of the Specification, where it states:

Product A is a derivative of real coconut that goes from coconut milk, or a similar source material, to coconut cream powder, or a similar source material, through a delicate process called spray drying. Spray drying is a unit operation where a pumpable liquid feed is finely dispersed or atomized to form droplets, which are sprayed into a heated air chamber. The process facilitates the dehydratacion of the feed droplets, thus forming the powder particles. The powder is then conveyed to a highly efficient

cyclone where product is collected in a container while the spent drying air is exhausted to the atmosphere.

“Claim 1” and “Claim 8”

Applicant amended claim 1 and cancelled claim 8 to specify that the coconut milk is spray dried and not “A spray dried rich creamy coconut mixture” or “A method to develop a spray dried rich creamy coconut mixture”.

“Claim 1”

Applicant corrected the spelling of the word dehydration and has taken the Examiner’s suggestion of including a “to” instead of an “and” in front of “facilitate” in claim 1.

Rejection under 35 U.S.C. 103(a) over Leaflet No. 8, 1983, in view of Tayag (PH26114) and Beyerinck et al. (6,763,607).

“Claim 1” and “Claim 7”

Applicant respectfully submitted for the Examiner’s consideration that neither Leaflet, Tayag, nor Beyerinck, singly or combined, teach or lead someone skilled in the art to the invention claimed by Applicant. The product formed by the Applicant is different and unique, unlike that of Leaflet, Tayag, or Beyerinck, singly or combined, wherein the rich creamy coconut mixture consists of water and a contained and preserved liquid base that is

developed from mixing water, sugar and a coconut cream powder derivative of natural coconut that is processed from natural coconut milk. The coconut milk itself is processed through a spray drying process that is a unit operation where a pumpable coconut milk liquid feed is finely dispersed or atomized to form droplets that are sprayed into a heated air chamber to facilitate dehydration of the droplets, thus forming powder particles, and the powder particles are conveyed to a cyclone where said coconut cream powder is collected; and further consisting of sugar, ice, and the contained and preserved young coconut meat originating from the natural coconut at its immature stage **to resemble the texture, consistency, taste, and appearance of mixing natural coconut liquid endosperm with jelly-like meat of an immature said natural coconut recently picked from a coconut palm tree**. It is important that the coconut cream powder derivative comprises the natural coconut and a starch hydrolysis product. The starch hydrolysis product is maltodextrin and the young coconut meat contains mainly water. The jelly-like meat is collected, bleached and contained in a container with preservatives.

On April 27, 2006, Attorney had a telephonic interview with Examiner Helen F. Pratt wherein the Examiner suggested use of “consisting of” in the Preamble to further limit the invention.

The Applicant respectfully presents in this Brief that comparative testing can often be avoided by defining the inventive

product in terms of composition and/or structure alone, and by distinguishing the inventive product from the prior art based thereon.

Applicant's invention is distinguishable and innovative because many geographical areas do not have coconut trees and therefore people in those areas cannot enjoy a coconut mixture having the characteristics as that of the Applicant's claimed invention.

We must keep in mind that case law has traditionally held that the scope of a product by process claim is limited by the process stated as referred to in the Supreme Court decision of 1884 (**Cochrane v. Badische Anilin & Soda Fabrik**, 111 U.S. 293 (1884)). The Federal Circuit panel hearing the Atlantic Thermoplastic case, **Atlantic Thermoplastics Co Inc. v. Faytex Corp**, 23 USPQ 2d 1481 (Fed. Cir. 1992) rehearing denied, 24 USPQ2d 1138, believed that this was still good law today.

The Examiner cites **In re Thorpe**, "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a

different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted) (Claim was directed to a novolac color developer. The process of making the developer was allowed. The difference between the inventive process and the prior art was the addition of metal oxide and carboxylic acid as separate ingredients instead of adding the more expensive pre-reacted metal carboxylate. The product-by-process claim was rejected because the end product, in both the prior art and the allowed process, ends up containing metal carboxylate. The fact that the metal carboxylate is not directly added, but is instead produced in-situ does not change the end product.).

The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) (holding "interbonded by interfusion" to limit structure of the claimed composite and noting that terms such as "welded," "intermixed," "ground in place," "press fitted," and "etched" are capable of construction as structural limitations.)

Applicant claims an invention that in fact is not the same as or obvious from a product of the prior art.

Applicant respectfully submits that Applicant's claimed invention is differentiated from Leaflet because Leaflet teaches making a coconut drink only having coconut in its raw natural state, without having a coconut in its raw natural state, it is impossible to make the coconut drink taught by Leaflet. Applicant noted that Applicant does not claim to have invented spray drying. Applicant's claim 1 is limited to a rich creamy coconut mixture that is made specifically with a spray drying method. Applicant respectfully submitted for the Examiner's consideration that neither Leaflet, Tayag, nor Beyerinck, singly or combined, teach or lead someone skilled in the art to make a rich creamy coconut mixture without having coconut meat from a coconut tree on hand. Applicant teaches a coconut cream powder that is obtained from a spray drying process. The addition of water to the liquid base ensures that the liquid base does not revert the liquid base to its original state. Applicant does not teach how to make coconut milk, but instead teaches how to make coconut mixture that is a cream.

Without Applicant's invention, a person would not have the ability to produce a coconut cream unless they had fresh coconuts readily available. Specifically, to convert coconut milk into a creamy coconut mixture, a person would have to have young coconut meat, but a person cannot add young coconut meat if they do not have fresh coconuts readily available. Applicant claims a

rich creamy coconut mixture that can be made without having the raw material in its natural stage, the young coconut meat.

Applicant has met the burden as to the product-by-process claims by submitting the above-referenced objective evidence by defining the impossibility of deriving a rich creamy coconut mixture without having the raw material in its natural stage, the young coconut meat.

In addition, Applicant respectfully submits that the Examiner has not overcome her burden in the proposed combination intended to anticipate the invention. This hurdle requires a showing of the teaching or motivation to combine prior art references. This cannot be said of the cited references taken singly or in combination. There is no logical suggestion or the application of any sound scientific principle that would have motivated, at the time of the invention, the interrelation of information elements, structure and characterization to implement the claimed invention.

It is clear that the Office has the burden of proof in the obviousness issue, and not the Applicant. *In re Reuter*, 210 U.S.P.Q. 249 (CCPA 1981). The Office has not met its burden. In *In re Dembiazac*, 50 U.S.P.Q. 2d 1614 (CAFC 1999), the Court stated:

"Our case law makes clear that the best defenses against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. *Id* at 1617."

The Court has previously reversed the Board in ***Interconnect Planning Corp. v. Feil***, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) for falling in the "hindsight trap". The invention must be viewed not with the blueprint (for piecing together the prior art to defeat patentability) drawn by the inventor, but in the state of the art that existed at the time. ***In re Dembiazac*** at 1617, citing ***Interconnect Planning Corp. v. Feil***, *supra*.

(J) CLAIMS APPENDIX

1. A rich creamy coconut mixture consisting of:

A) water;

B) a contained and preserved liquid base developed from mixing water, sugar and a coconut cream powder derivative of natural coconut that is processed from natural coconut milk through a spray drying process, said spray drying process is a unit operation where a pumpable said coconut milk liquid feed is finely dispersed or atomized to form droplets that are sprayed into a heated air chamber to facilitate dehydration of said droplets, thus forming powder particles, said powder particles are conveyed to a cyclone where said coconut cream powder is collected;

C) sugar;

D) ice; and

E) contained in a first container and preserved young coconut meat originating from said natural coconut at its immature stage to resemble texture, consistency, taste, and appearance of mixing natural coconut liquid endosperm with jelly-like meat of an immature said natural coconut recently picked from a coconut palm tree, said coconut cream powder derivative comprises said natural coconut and a starch hydrolysis product, said starch hydrolysis product is maltodextrin, said young coconut meat contains mainly water and said jelly-like meat which are collected, bleached and contained in a second container with preservatives.

7. The rich creamy coconut mixture set forth in claim **1**, further comprising vanilla extract.

(K) EVIDENCE OF APPENDIX

- Evidence Cited by the Examiner in the First Office Action
 - Leaflet No. 8, 1983. Attached as Appendix "A".
 - Tayag (PH26114). Attached as Appendix "B".
- Evidence Cited by the Examiner in the Notice of Non-Compliant Amendment

None

- Evidence Cited by the Examiner in the Second Office Action (Final)
 - Leaflet No. 8, 1983
 - Tayag (PH26114)
 - Beyerinck et al. (6,763,607). Attached as Appendix "C".
- Evidence Cited by the Examiner in the Second Advisory Action

None

(L) RELATED PROCEEDINGS APPENDIX

None.

Applicant believes his application is allowable and ready to be passed to publication and requests an early favorable action from the Board of Appeals.

Respectfully submitted,
Albert Bordas, P.A.
Attorneys for Applicant
5975 Sunset Drive, Suite 607
Miami, Florida 33143
Tel. 305-669-9848
Fax 305-669-9851

By: /Albert Bordas/
Albert Bordas, Esq.
Reg. No. 45,595